

IV. AMENDMENTS TO THE DRAWINGS

- THE DRAWINGS OF THE PATENT IS HEREBY AMENDED AS SET FORTH BELOW:

- There are no amendments to the drawings.

V. REMARKS/ARGUMENTS

- STATUS OF THE CLAIMS

Claims 48 through 55 are pending. Claims 1 through 47 have been canceled. No new matter has been added.

- REJECTION UNDER 35 U.S.C. §103

- Examiner's Stance

Claims 40, 41, 45, 47-53 and 54 are rejected under 35 USC 103(a) as obvious over previously cited Ravkin (US 6,169,816) in view of Tisone (US 2004/0072364), further in view of Rutenberg (US 5,287,272) and even further in view of Atwood (US 5,681,741)

In the Examiner's opinion, the claimed automatic microscope system comprising a dispensing reagents, a thermocycler and a transporter is *prima facie* obvious over the combined references.

Concerning Claim 48, Examiner alleges (last line of page 4 and first line page 5 of the Office Action) that Ravkin "[t]eaches that the microscopic system is computerized (column 5, line 66-67 to column 7, lines 1-5) ... compris[ing] processors that are linked with any number of peripheral devices (column 6, lines 1-7)." Examiners remarks on page 4 line 12 (and pages 7 last line and page 10 line 2) of the office action that Ravkin "...specifically teaches interfacing a computer to external instruments (column 5, line 22-25)." The Examiner then points out that Tisone specifically uses an EPROM to facilitate the interfacing systems such as that of Ravkin. The Examiner thus alleges that the instant claims would be obvious.

- Applicant's Response

Applicant respectfully traverse the rejections of claims 48 through 55 under 35 U.S.C. §103(a). Claims 1 through 47 have been canceled thereby mooted their rejection.

With respect to instant claim 48, the Applicant asserts that the Examiner cited prior art references do not provide sufficient grounds for establishment of a *prima facie* case of

obviousness, as set forth in Graham v. John Deere Co., 383 U.S. 1, 148 USPQ 459 (1966), summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or non-obviousness.

The elements of instant claim 48, in part, comprise:

(ii) automatically recording coordinates of said cell candidate, or said blob comprising said labeled rare cell, in the optical field;

(iii) automatically locating said reagent dispenser over said cell candidate, or cell blob comprising said cell candidate, based on said position coordinates; and

(iv) automatically dispensing reagent from said reagent dispenser onto said cell candidate, or said blob comprising said cell candidate.

Ravkin does not teach the elements of claim 48 that are drawn to the computer controlled dispensing system.

The limitations of the instant claim are not taught by Tissone. Tissone discloses that:

"...[i]t is a principle object and advantage of the present invention...to provide an improved dispensing apparatus and method for accurately and precisely dispensing various desired patterns of reagent onto a substrate, micro-well plate or other receptive surface or receptacle. The accuracy and precision is such that the resulting patterns can be precisely registered with a sample to be tested...The invention also allows for a dispensing apparatus and

method for dispensing any one of a number of user-defined patterns on a substrate without requiring the user to manually program the dispenser or associated X-Y or X-Y-Z table." [Tissone; para. [0019]] (emphasis added)

Each of the Tissone independent claims require, respectively, *dispense droplets of said liquid reagent...to form said desired reagent pattern* [Tissone; claim 1]; *dispensing desired patterns of liquid reagent...*[Tissone; claim 12]; and *dispense droplets of said fluid ...to form said desired fluid pattern* [Tissone; claim 18]. Tissone does not teach or suggest the *dispensing reagent from said reagent dispenser onto an empirically determined cell candidate or said blob.*

Neither Atwood nor Rutenberg disclose or claim a relevant reagent dispensing system.

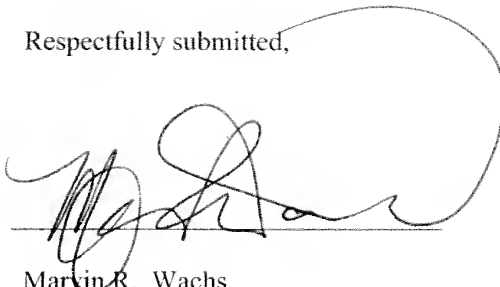
In accordance with MPEP 2143.03, to establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. Applicant respectfully asserts that Ravkin, Tissone, Rutenberg, and Atwood, taken singly or in combination, do not provide a *prima facie* case of obviousness. Claims 49 through 55 depend from claim 48. In accordance with MPEP 2143.03, if an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious.

Applicant requests reconsideration and withdrawal of the rejection of independent claim 48 and dependent claims 49 through 55.

CONCLUSION OF REMARKS

Applicant assert that this response is a good faith effort to place the application in condition for allowance. Applicant respectfully seek early allowance of the pending claims.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'M. Wachs', is written over a horizontal line. The signature is stylized with a large, looping flourish extending to the right.

Date: July 9, 2009

Marvin R. Wachs,
Reg. No.: 58,227
KELLEY DRYE & WARREN LLP
400 Atlantic Street
Stamford, CT 06901
Phone 203-351-8072
Fax: 203-327-2669
E-mail: mwachs@kelleydrye.com

VI. APPENDIX

- *No appendix is intended to be attached*